

Appln No.: 10/646,436
Amendment Dated: February 16, 2006
Reply to Office Action of January 9, 2006

REMARKS/ARGUMENTS

This is in response to the Office Action mailed January 9, 2006 for the above-captioned application. Reconsideration and further examination are respectfully requested.

Claims 4 and 14 have been amended to refer only to Seq. ID Nos. 1-16. This amendment is believed to overcome the priority issue with respect to these claims. It is noted that the Examiner asserts that provisional application does not provide adequate support for Seq. ID No. 10 from this list. Applicants attach a copy of Table 1 from the provisional application with the sequence of claim 10 highlighted. Thus, Applicants submit that claims 4, 10, 11, 14, 31 and 33 should be afforded the filing date of the provisional application.

The Examiner rejected claims 10 and 11 under 35 USC § 102(b)¹ and claims 1-2 and 12 under 35 USC § 102(e) as anticipated by Monia. Based on the written response, and a brief telephone conversation with the Examiner on February 16, 2006, it appears that the Examiner did not understand the nature of Applicants argument with respect to this reference. Accordingly, the argument is amplified here, and further consideration is requested.

The entire disclosure of the Monia et al patent concerning RNA oligonucleotides as inhibitors is that which the Examiner has cited, namely the single passage in Col. 6. Monia does not disclose even one actual RNA sequence. Thus, Applicants submit that Monia does provide an enabling disclosure of the invention as claimed.

"Prior art under §102(b) must sufficiently describe a claimed invention to have placed the public in possession of that invention." *In re Elsner*, 72 USPQ2d 1038, 1041 (Fed. Cir. 2004). A patent claim "cannot be anticipated by a prior art reference if the allegedly anticipatory disclosures cited as prior art are not enabled." *Elan Pharm., Inc. v. Mayo Found. for Med. Educ. & Research*, 346 F.3d 1051, 1054, 68 USPQ2d 1373, (Fed. Cir. 2003). All Monia et al provide is an invitation to experiment, not a disclosure of RNA sequences, and thus the reference does not place the public in possession of the presently claimed invention. Accordingly, Applicants again submit that this rejection should be withdrawn.

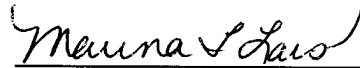
For these reasons, this application is now considered to be in condition for allowance and

¹ Based on granting of the claim for priority, this should be 102(e).

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such action is earnestly solicited. Recombination and consideration of the non-elected sequence claims, and of the method of use claims are also requested.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "Marina T. Larson", is written over a horizontal line.

Marina T. Larson, Ph.D
Attorney/Agent for Applicant(s)
Reg. No. 32038

(970) 262 1800

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